

ESTTA Tracking number: **ESTTA363828**

Filing date: **08/18/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Stanley Logistics L.L.C.
Granted to Date of previous extension	08/18/2010
Address	1000 Stanley Drive New Britain, CT 06053 UNITED STATES

Correspondence information	David S. Modzeleski Attorney for Opposer Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES modzeleski.david@arentfox.com, davis.jim@arentfox.com Phone:(202) 857-6000
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### Applicant Information

Application No	77878721	Publication date	04/20/2010
Opposition Filing Date	08/18/2010	Opposition Period Ends	08/18/2010
Applicant	KINETIK TOOLS INC 15432 VALLEY BLVD CITY OF INDUSTRY, CA 91746 UNITED STATES		

### Goods/Services Affected by Opposition

Class 008. All goods and services in the class are opposed, namely: Hand tools, namely, hammers; Hand tools, namely, nail sets; Hand tools, namely, nippers; Hand tools, namely, nut drivers; Hand tools, namely, ratchet wrenches; Hand tools, namely, socket sets; Hand tools, namely, socket wrenches; Hand tools, namely, wrecking bars, stripping bars, small bars and nail pullers, San Angelo bars, tamper bars, wedge point bars, pitch point bars; Hand tools, namely, wrenches
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### Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Application void for misidentification of applicant, Trademark Act section 1(a)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1472816	Application Date	10/21/1985
Registration Date	01/19/1988	Foreign Priority Date	NONE
Word Mark	JTK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1964/09/00 First Use In Commerce: 1964/09/00 [ METAL CASES FOR TOOLS ]</p> <p>Class 008. First use: First Use: 1964/09/00 First Use In Commerce: 1964/09/00 HAND TOOL SETS, EACH CONSISTING OF ALL TYPES OF WIRE AND CABLE STRIPPERS, PUNCHES, POCKET KNIVES AND SHEATHS, KNIFE SHARPENERS, GAS TORCHES, SCREWDRIVERS, GAS SOLDERING IRONS, RATCHETS, PRECISION TOOLS, HEX TOOLS, NUT DRIVERS, WRENCHES, FASTENING TOOLS, PLIERS, CUTTERS, SHEARS, HEMOSTATS, WIRE TWISTERS, SOCKET SETS, TWEEZERS, PICKUP TOOLS, PUNCHES, HACKSAWS, HAMMERS, SCISSORS, PIN VISES, UTILITY KNIVES, ELECTRICIANS' KNIVES, FILES, STRIPPERS, CRIMPERS, CONNECTING TOOLS, WORKPIECE HOLDERS, REAMERS, RIVETERS, BURNISHERS, AND TOOL BOXES AND CASES SOLD WITH THE FOREGOING</p>		

U.S. Registration No.	1889689	Application Date	12/29/1993
Registration Date	04/18/1995	Foreign Priority Date	NONE
Word Mark	JTK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 tool kits consisting of pocket rules; tape measures; calipers; feeler gauges; inspection mirrors; magnets; outlet testers; tool kits consisting of telephone line testing and adapting equipment, namely digital multimeters, punch down tools, audio tone generators and line aids for locating cable pairs, rotary tone handset for line testing and temporary communication modular phone line tester; static dissipating wrist straps, mats and grounding cords; tool kits consisting of equipment used for repairing and preparing fiber optic cables, namely cable tie tool, coaxial cutter, scissors, screwdrivers, wire strippers, wrenches, knives, tweezers, spudgers, microforks, reamers, pliers, crimping tools, fiber scribes; and testing equipment, namely oscilloscopes and multimetres</p> <p>Class 011. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 tool kits consisting of pen lights; illuminated magnifiers; and industrial lights</p> <p>Class 018. First use: First Use: 1983/03/00 First Use In Commerce: 1983/03/00 tool carrying cases made of nylon, plastic or canvas and parts and pallets therefor</p>		

U.S. Registration No.	2623959	Application Date	04/03/2001
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Registration Date	09/24/2002	Foreign Priority Date	NONE
Word Mark	JTK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 MAIL ORDER CATALOG SERVICES AND ELECTRONIC CATALOG SERVICES FEATURING TEST INSTRUMENTS AND TOOLS SOLD SEPARATELY AND IN KITS, AND EMPTY CASES FOR SAME		

Attachments	76234296#TMSN.gif ( 1 page )( bytes ) Notice of Opposition.pdf ( 7 pages )(299663 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David S. Modzeleski/
Name	David S. Modzeleski
Date	08/18/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 77/878,721 for the mark JTC AUTO TOOLS filed on November 23, 2009 and published on April 20, 2010.

Stanley Logistics, LLC

Opposer,

v.

Kinetik Tools Inc.

Applicant.

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Opposition No. \_\_\_\_\_

BOX TTAB FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313

**NOTICE OF OPPOSITION**

Stanley Logistics, LLC, a limited liability company organized under the laws of Delaware, believes that it will be damaged by the registration of the mark JTC AUTO TOOLS (the “Disputed Mark”), the subject of application Serial No. 77/878,721 (the “Application”) filed by Kinetik Tools Inc. (“Applicant”), a California corporation with an address of 15432 Valley Boulevard, City of Industry, CA 91746. Stanley hereby opposes the Disputed Mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Stanley alleges as follows:

1. Stanley Logistics, LLC is a wholly-owned subsidiary of Stanley Black & Decker, Inc. (“Stanley”). Stanley is renowned in the U.S. and around the world as a leading

manufacturer and marketer of tools, tool kits, and a wide variety of other products for home improvement, consumer, industrial and professional use.

2. For over 40 years Stanley has used its JTK mark (the “JTK Mark”) to advertise and promote its goods and services. Stanley owns several federal trademark registrations for the JTK Mark, including the following:

<b>Reg. Nos.</b>	<b>Mark</b>	<b>Goods</b>
1,472,816	JTK	Hand tool sets, each consisting of all types of wire and cable strippers, punches, pocket knives and sheaths, knife sharpeners, gas torches, screwdrivers, gas soldering irons, ratchets, precision tools, hex tools, nut drivers, wrenches, fastening tools, pliers, cutters, shears, hemostats, wire twisters, socket sets, tweezers, pickup tools, punches, hacksaws, hammers, scissors, pin vises utility knives, electricians’ knives, files, strippers, crimpers, connecting tools, workpiece holders, reamers, riveters, burnishers, and tool boxes and cases sold with the foregoing, in Class 8.
1,889,689	JTK	<p>Tool kits consisting of pocket rules; tape measures; calipers; feeler gauges; inspection mirrors; magnets; outlet testers; tool kits consisting of telephone line testing and adapting equipment, namely digital multimeters, punch down tools, audio tone generators and line aids for locating cable pairs, rotary tone handset for line testing and temporary communication modular phone line tester; static dissipating wrist straps, mats and grounding cords; tool kits consisting of equipment used for repairing and preparing fiber optic cables, namely cable tie tool, coaxial cutter, scissors, screwdrivers, wire strippers, wrenches, knives, tweezers, spudgers, microforks, reamers, pliers, crimping tools, fiber scribes; and testing equipment, namely oscilloscopes and multimetres, in Class 9.</p> <p>Tool kits consisting of pen lights; illuminated magnifiers; and industrial lights, in Class 11.</p> <p>Tool carrying cases made of nylon, plastic or canvas and parts and pallets therefor, in Class 18.</p>
2,623,959	JTK	Mail order catalog services and electronic catalog services featuring test instruments and tools sold separately and in kits, and empty cases for same, in Class 35.

3. Stanley's federal registration No. 1,472,816, No. 1,889,689, and No. 2,626,959 are incontestable and provide *conclusive* evidence of Stanley's registration of the JTK Mark, Stanley's ownership of the mark, and of Stanley's exclusive right to use the mark in commerce on or in connection with the goods and services specified in the registrations.

4. Stanley also owns common law trademark rights in its JTC Mark (the "JTC Mark") and uses the JTC Mark in connection with the promotion and sale of various goods and services, including hand tools and tool kits.

5. Stanley used and acquired trademark rights in the JTK Mark and the JTC Mark (collectively and hereinafter "Stanley's Marks" or "the Marks") long before November 23, 2009, the date on which Applicant filed the Application.

6. Stanley's rights in the Marks are senior to any trademark rights Applicant may claim in the Disputed Mark.

7. Stanley has expended substantial resources and money marketing, advertising, and promoting the Marks throughout the United States in connection with Stanley's hand tools, tool kits, and related products.

8. By reason of its extensive marketing, advertising, and promotion, the Marks have become uniquely associated with Stanley.

9. The Marks have become well-known and famous as distinctive indicators of the origin of Stanley's goods and services, and are valuable symbols of Stanley's goodwill.

10. The Marks are fanciful, arbitrary, inherently distinctive, and therefore strong and entitled to a broad scope of protection.

11. Notwithstanding Stanley's prior rights in the Marks, Applicant is seeking to register the Disputed Mark, as shown below, for "hand tools, namely, hammers; hand tools,

namely, nail sets; hand tools, namely, nippers; hand tools, namely, nut drivers; hand tools, namely, ratchet wrenches; hand tools, namely, socket sets; hand tools, namely, socket wrenches; hand tools, namely, wrecking bars, stripping bars, small bars and nail pullers, San Angelo bars, tamper bars, wedge point bars, pitch point bars; hand tools, namely, wrenches” in Class 8.



12. As the Disputed Mark prominently features the letters “JTC,” it so closely resembles Stanley’s Marks that the concurrent use and registration of the marks are likely to cause confusion, mistake, and deception as to the source or origin of Applicant’s goods and will injure and damage Stanley and the goodwill and reputation symbolized by Stanley’s Marks. The Disputed Mark is confusingly similar to the JTK Mark both in terms of the letters JTK and JTC, and by virtue of the stylization used in the Disputed Mark, in which the letter C is stylized in a way that resembles a K.

13. The goods identified in the Application are highly related or identical to the goods and services protected under Stanley’s federal registrations for the JTK Mark, and the goods Stanley promotes and sells under the JTC Mark.

14. Stanley is not related to Applicant and has not authorized Applicant to use or register the Disputed Mark.

15. Stanley believes that it will be damaged by the registration of the Disputed Mark.

**COUNT I – LIKELIHOOD OF CONFUSION – § 2(d)**

16. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 15 above.

17. The Disputed Mark so resembles Stanley's Marks that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and will injure and damage Stanley and the goodwill and reputation symbolized by Stanley's Marks.

18. Applicant's goods are highly related or identical to the goods and services of Stanley such that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Stanley or that Applicant is in some way connected with, sponsored by, or affiliated with Stanley, all to Stanley's irreparable damage.

**COUNT II – DECEPTION/FALSE SUGGESTION OF CONNECTION – § 43(a)**

19. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 18 above.

20. Applicant's Disputed Mark so closely resembles Stanley's Marks that it is likely to cause deception in violation of Section 2(a) of the Trademark Act in that the mark misdescribes the origin of the goods and services, purchasers are likely to believe that the misdescription actually describes the origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Stanley's goods and services.

21. Applicant's Disputed Mark so resembles Stanley's Marks that it falsely suggests a connection with Stanley in violation of Lanham Act Section 2(a).



### **COUNT III – DILUTION – § 43(c)**

22. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 21 above.

23. Stanley's Marks have been widely used and extensively publicized in the United States and have become well-known and famous within the meaning of the Lanham Act § 43(c) as a distinctive symbol of Stanley's goodwill.

24. Applicant's Disputed Mark will dilute the distinctive quality of Stanley's Marks.

25. The use or registration of Applicant's Disputed Mark will lessen the capacity of Stanley's famous Marks to identify and distinguish Stanley's goods and services.

26. By reason of the foregoing, Stanley asserts that it will be damaged by the registration of Applicant's Disputed Mark and hereby opposes the Application under 15 U.S.C. § 1052.

### **COUNT IV– APPLICATION VOID FOR MISIDENTIFICATION OF APPLICANT – § 1(a)**

27. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 26 above.

28. On information and belief, the Application was and is *void ab initio* because it was filed by an entity other than the owner of the mark identified therein.

29. This misidentification of ownership is an incurable defect in the Application, which is therefore fatally flawed and invalid.

WHEREFORE, Stanley prays that this opposition be sustained and that registration be denied.

Respectfully submitted,

STANLEY LOGISTICS, LLC

Dated: August 18, 2010

By:



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